

REMARKS

Claims 1-46 are pending in this application, all of which have been rejected as being anticipated by U.S. Patent No. 5,715,403 (Stefik). Applicants respectfully disagree with the grounds for rejection, and request reconsideration of the rejection.

On August 12, 2004, a telephonic interview was held between Examiner Elisca and the undersigned. At the interview, claims 1, 4, 6, 8, and 37, and the Stefik reference, were discussed. No agreement was reached. However, the thrust of applicants argument was that each of these claims recited specific features that were not taught in Stefik, and that the July 22, 2004 Final Rejection does not address points previously raised by applicants in response to the January 9, 2004 Office Action. The Examiner stated that applicants should set forth their arguments in the form of a written response, and, based on these arguments, the Examiner would consider whether these claims should be allowed, or if another reference needs to be cited, and would consider withdrawing the finality of the rejection if different references needed to be cited.

Thus, applicants set forth their arguments below. It should be noted that the these arguments are essentially summaries of arguments that were previously raised by applicants in the paper that was filed on April 26, 2004. Applicants respectfully submit that these arguments should be considered after final, because they were not sufficiently addressed in the Final Rejection.

Claims 1, 14, 15, 20, 28, and 38

Claims 1, 14, 15, 20, 28, and 38 call for a license that specifies the terms on which some subsequent license may be issued. Applicant raised this point in response to the previous office action, and the Examiner appears to have treated this argument as if applicants had argue that "None of the cited portions teach or suggest the act of licensing a digital work." (See Final Rejection, p. 4.) Applicants did not argue that Stefik failed to teach the licensing of a digital work. Rather, applicants have argued that Stefik does not teach a license that specifies the terms or conditions on which a further license may issue. Applicants request reconsideration of claims 1, 14, 15, 20, 28, and 38 on this point, and submit that these claims should be allowed.

Claims 4, 15, 18, 22, 23, 32, 44, and 45

These claims recite various feature relating to the idea that a payment is a condition for the licensure of content. With respect to these claims, the Examiner has cited Stefik's teaching to the effect that rights can specify collection of a payment as a condition for content usage. However, an existing license that calls for a payment as a condition for *using* the licensed content, is not the same thing as payment being a condition on the issuance of a license. In the former instance, the license already exists, and payment is only a condition on using the licensed content. In the latter, case, the license may, or may not, come into existence depending on whether the payment is received. Applicants request reconsideration of the rejection of claims 4, 15, 18, 22, 23, 32, 44, and 45 based on the foregoing point, and submit that these claims are in condition for allowance.

Claims 6, 19, 24, 33, and 46

Claims 6, 19, 24, 33, and 46 recite features relating to the idea that a license is either revoked or made unusable as a condition for issuing another license. Stefik does not teach these features. As applicants pointed out in the paper filed on April 26, 2004, the Examiner has not addressed this feature in the first Office Action, and the Examiner has not responded, in the Final Rejection, to applicants' prior argument on this point. Applicants respectfully submit that Stefik does not teach this feature. Thus, applicants request reconsideration of the rejection of claims 6, 19, 24, 33, and 46, and submit that these claims are in condition for allowance.

Claim 8

Claim 8 recites features that, when taken together, effectively require content and its corresponding license to be transmitted separately. As noted in the April 26, 2004 paper, Stefik teaches that rights and content travel together, and the Examiner has not pointed to any portion of Stefik that calls for rights and content to travel separately. In view of this point, applicants respectfully request reconsideration of the rejection of claim 8, and submit that claim 8 is in condition for allowance.

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**PATENT
REPLY FILED UNDER EXPEDITED
PROCEDURE PURSUANT TO
37 CFR § 1.116**

Claim 37

Claim 37 recites features that, when taken together, call for a license that permits content to be licensed on first and second computing devices, but not on a third computing device. As explained in the interview, the feature that the content is not licensable on a third computing device effectively means any third computing device – i.e., the content is licensable only on the first and second devices, but not on any other (third) device. The Examiner has not pointed to any portion of Stefik that teaches this feature. In view of this point applicants respectfully request reconsideration of the rejection of claim 37, and submit that claim 37 is in condition for allowance.

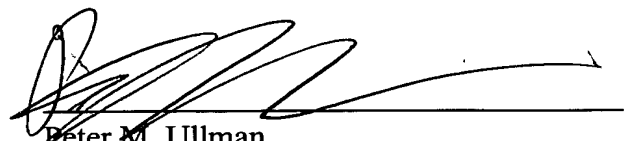
Drawings

The Examiner has not indicated whether the formal drawings filed with the application have been accepted. It is respectfully requested that the Examiner indicate in the next Office Action that the formal drawings filed with this application have been accepted.

Conclusion

Claims 1, 6, 8, 14, 15, 18, 19, 20, 22-24, 28, 32, 33, 37, and 38 have been shown to be patentable, and the remaining claims are thus patentable at least by reason of their dependency. Applicants thus respectfully submit that the rejection of claims 1-46 should be reconsidered after final, and respectfully submit that this case is in condition for allowance.

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